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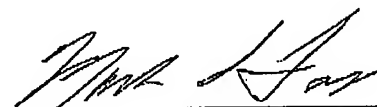
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  A1019/20354	
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		First Named Inventor  James Kevin Gillie	
		Art Unit  1711	Examiner  Thao T. Tran
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the  <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number 24.364		 Signature  Martin L. Faigus Typed or printed name  (215) 567-2010 Telephone number  April 19, 2006 Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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## PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
PATENT EXAMINING OPERATION

First Named Inventor: James Kevin Gillie

Serial No: 10/803,360

Group Art Unit: 1711

Filed: March 18, 2004

Examiner: Thao T. Tran

Att. Docket No.: A1019/20354

Confirmation No.: 5836

For: URETHANE BASED COATING APPLIED IN-LINE FOR IMPROVED INK  
ADHESION**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REMARKS**

This is a request for review of the Final Rejection of Claims 1 - 24 "under 35 U.S.C. 103 (a) as being unpatentable over Kinoshita et al. (US Pat. 5,824,394) in view of Posey et al. (US Pat. 4,525,419)," rendered by the Examiner on November 30, 2005.

On January 19, 2006, applicant filed a responsive argument to the Final Rejection, and on February 3, 2006, the Examiner submitted a response in which he took the position that the Final Rejection stands. Applicant also requests a review of the position taken by the Examiner in his February 3, 2006 response to support the Final Rejection.

This invention relates to a printable, coated, biaxially oriented plastic film wherein the polymeric base film includes polypropylene as the predominant polymer, and wherein a urethane coating is provided on a first side of the film, with the coating being applied to the polymeric base film between the machine direction orientation and the transverse direction orientation of a two-step tentering operation. A tentering operation is an operation wherein a film is extruded through an extrusion die, first oriented, or stretched in a machine direction and then subsequently stretched in a cross-machine direction to provide for biaxially orientation. In this invention, the urethane coating is applied between the machine direction and cross-machine direction orientation steps, to achieve unexpected, improved results when coated on a polymeric base film that has, as its predominant polymer, polypropylene.

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Claim 1, which is the only independent claim presented for consideration, is as follows:

"A printable, coated biaxially oriented film, comprising:

- (a) a polymeric base film having a predominant polymer, and a first and a second side, said predominant polymer being polypropylene; and
- (b) a urethane coating on said first side, said coating having been applied to said base film between a machine direction orientation and a transverse direction orientation of a two step tentering operation."

Applicant is filing this Pre-appeal Request because it believes that there is a clear deficiency in the alleged prima-facie case of obviousness set forth by the Examiner.

Applicant submits that there is no proper basis for combining the teachings in the Kinoshita et al. '394 patent and the Posey et al. '419 patent to support the rejection rendered by the Examiner.

First, as recognized by the Examiner, the Kinoshita patent does not teach that the base film of the disclosed film should be predominately polypropylene. To attempt to overcome this deficiency, the Examiner cited the Posey '419 patent, which broadly suggests that, in the context of the invention disclosed therein, the base film of the laminate could be an oriented polyester or polypropylene film, referring to column 3, lines 25 - 30. Based upon this teaching in Posey the Examiner took the position that it would have been obvious to one of ordinary skill in the art to have employed the polypropylene film as taught by Posey as the base film in the Kinoshita structure. To attempt to justify this substitution, the Examiner took the position that Posey teaches that a polypropylene film is an equivalent of a polyester-based film, and therefore to substitute one for the other in the Kinoshita structure would be obvious.

Applicant submits that this rejection is fatally flawed because there is absolutely no motivation for the combination proposed by the Examiner, and absolutely no suggestion that a polypropylene film and a polyester-based film would be considered equivalent in the Kinoshita structure.

In addition, the Posey et al. '419 patent actually teaches that a polyester-based film and a polypropylene film are not equivalent structures for all purposes, and clearly does not provide a teaching that a polypropylene film would be equivalent to the specified polyester film employed in the Kinoshita patent.

In fact, each of the cited references actually teaches away from making the combination proposed by the Examiner, for the reasons set forth hereinafter.

The Kinoshita et al. '394 invention is specifically directed to a biaxially oriented laminated

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polyester film, and specifically, that a layer of an acrylic-based resin or a urethane-based resin can be provided on the surface of a polyester layer A of only a specified composition. There is absolutely no motivation or no suggestion that a different polymer can be used in place of the polyester layer A. In fact, Kinoshita et al. specifically state that their invention resides in the use of the specifically disclosed polyester layer A for receiving either an acrylic-based resin or urethane-based resin coating. In particular, note the paragraph beginning on line 16 of column 2, which reads as follows:

“As a result of the present inventors’ studies for overcoming the above problems, it has been found that by use of a polyester film having a specific construction, it is possible to remarkably improve adhesiveness of the polyester film layer to any kind of functional layer. On the basis of the finding the present invention has been attained.” (emphasis added)

Thus, the Kinoshita et al. invention, as disclosed to a person skilled in the art, is that the specific polyester film layer for receiving either an acrylic-based resin or a urethane-based resin must be a polyester film having the composition specified therein. Specifically, neither the layer A or the layer B of the laminated polyester film can include predominantly polypropylene.

Thus, to modify the Kinoshita et al. structure in the manner suggested by the Examiner would directly destroy the teachings in the Kinoshita patent. Stating this another way, the Kinoshita et al. patent actually teaches away from providing a base film that is predominantly polypropylene.

Although the above-discussed teachings in the Kinoshita et al. ‘394 patent should put the obviousness issue to rest, let’s consider what the Posey et al. ‘419 patent teaches to a person skilled in the art.

The alleged inventive concept or feature in the Posey et al. ‘419 patent is the specific primer identified therein. Apparently Posey et al. did not want to limit their invention to the use of only a single base film, in view of the fact that the inventive feature apparently was not in the base film, but rather in the specific copolyester primer coatings described and claimed therein. The fact that the polyester primer coatings are the inventive features is specified throughout the Posey et al. patent. For example, Posey et al. state: “In the synthesis of the copolyester primer coatings of this invention ... .” (Column 5, lines 57, 58) (emphasis added); “The copolyester primer coatings of this invention exhibit excellent heat stability ... .” (Column 6, lines 35, 36) (emphasis added); “Plastic film primed with the copolyester composition of this invention has excellent utility as a film base ... .” (Column

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6, lines 50, 51) (emphasis added).

Moreover, claim 1 specifically identifies the composition of the copolymer primer coating forming a critical part of the disclosed invention.

Most interestingly, although Posey et al. discloses employing the inventive primer on both a polyester and a polypropylene film, it also teaches that a polypropylene film and a polyester film are not equivalent films for all purposes. In particular, note Table 2 appearing in column 14, which presents data relating to ink adhesion for four different ink types on various film, including polypropylene and polyester. The "Control" identified in Table 2 is the specific film without the use of any primer. The reference to "Sample" refers to the films with the inventive copolyester coatings thereon.

As can be seen in the far right-hand column of the Table, which presents data with respect to the use of a polyamide ink type, a polypropylene film without the primer had zero ink adhesion while a polyester film without the primer had 100% ink adhesion. This clearly shows that polypropylene and polyester are not equivalents with respect to ink adhesion, and that they are only recognized as both having apparently acceptable ink adhesion properties when the inventive copolyester primer coating is employed.

Also note the data in Table 2 relating to the use of Solvent Flexo ink on a polypropylene and polyester films. Specifically, although the control for both films had zero ink adhesion, it should be noted that the ink adhesion properties of these two films were different from each other, even with the same inventive polyester primer coating being employed. Specifically, the ink adhesion on the polypropylene film coated with copolyester primer was 50% and the ink adhesion with a polyester film coated with the copolyester primer coating was 100%. Thus, although these two different levels of ink adhesion may be acceptable within the scope of the Posey et al. invention, there clearly was a substantial difference in ink adhesion even with the same primer. This further demonstrates that polypropylene and polyethylene film are not equivalent for all purposes.

Based upon the above analysis it should be apparent that the Examiner's position, as set forth in his response of February 3, 2006, is not well taken. Specifically, the Examiner stated:

"Applicant contends that Posey cannot be used to remedy Kinoshita because Posey does not teach a polypropylene and a polyester film to be equivalent. However, as pointed out in

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the Final rejection, since Posey teaches a laminate comprising a base film of polypropylene or polyester with a coating, the use of one film would have been obvious over the other. And since the polyester film of Kinoshita also contains 1-25% polypropylene, whereas that of Posey can be polyester or polypropylene, Posey would remedy the invention of Kinoshita."

Applicant submits that the rationale presented by the Examiner is a non-sequitur. What Posey does teach is that a laminate comprising a base film of polypropylene and polyester with the inventive coating apparently are both acceptable with respect to ink adhesion. However, they clearly do not have equivalent performance characteristics with all adhesives, even when the inventive coating is employed.

Most significantly, the invention in Kinoshita is predicated on forming a laminate film having the specifically described polyester layers; neither of which can include predominantly polypropylene. To attempt to replace the disclosed polyester film layers in Kinoshita with a polymer that is predominantly polypropylene would be contrary to the teachings of Kinoshita, and actually destroy the teachings in Kinoshita.

The remaining claims are either directly or indirectly dependent upon claim 1 and are submitted to be patentable for the same reasons as claim 1. Moreover, claims 18 – 20, each of which are dependent on claim 1, describe preferred polypropylene film compositions.

In view of the above remarks, Applicant submits that the rejection of claim 1 and the remaining dependent claims should be withdrawn and this application should be passed to publication.

Respectfully submitted,

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